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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,820	08/04/2003	Brian D. Zelickson	43154.70	7509
23639	7590	08/25/2005	EXAMINER	
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO CENTER 18 FLOOR SAN FRANCISCO, CA 94111-4067			LACYK, JOHN P	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/633,820	ZELICKSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John P. Lacyk	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 95-120 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 95-120 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/25/05</u>  | 6) <input type="checkbox"/> Other: _____                                    |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/25/05 has been entered.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 95-120 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,604,004. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is directed to a species or a more specific embodiment while the application is directed to the genus or broader embodiment. However since the patent is already issued to the species it would anticipate the genus.

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The pending claims are broader in scope with the elimination of the observation and control pieces and a plurality of antenna, which are claimed in further dependent claims.

The Terminal Disclaimer filed 07/25/05 is not accepted in that the appropriate disclaimer statement is missing. It appears that there is a gap with missing language between pages 1 and 2 of the Terminal Disclaimer, on page 1 the last line is "The evidentiary documents have been reviewed and as of the signing of the Terminal" and the first line of page 2 is "Patent 6,604,004, and hereby agrees...". It appears that the proper language between the two portions is missing.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 104-105, 110-112, 119-120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 104-105, 110-111, 119-120, these claims are merely directed to the part of the body where the device is placed and fail to further define any structural limitations of the device itself. With respect to claim 112, in line 17, "of a type" is indefinite in that the phrase "of a type" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "of a type"), thereby rendering the scope of the claim(s) unascertainable.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 95-101, 104-107, 110-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sogawa et al in view of Abele et al.

Sogawa et al discloses a device for treating tissue by heating comprising an elongate insertion device (1); an energy source at the proximal end (3); an energy transmitting device or microwave antenna (18) at the distal end and the energy source connected to the transmitting device through the insertion device to transmit energy to a target area. The distal end portion has an expandable portion (8). Sogawa et al discloses the claimed device except for the device configured for insertion into a natural opening, the use of an RF source and the device being controllable to position the device. Abele et al discloses a device for treating tissue inside a patient's body having an antenna device surrounded by a balloon member, antenna connected to an RF source of energy for heating of tissue. Abele et al teaches that it is well known to use an endoscope to insert a similar device into an opening in the body of a patient, the balloon member, elongate device and antenna are sized to be inserted by way of an endoscope and the endoscope includes means for providing a light source and viewing means to allow for the device to be properly positioned within the body. Therefore a modification of

Sogawa et al to enable the device to be inserted through an endoscope would have been obvious in view of the teachings of Abele et al since this would provide a less intrusive, alternative way to insert the device which would further allow for visualization to properly position the device inside the treatment area. Further Abele et al teaches (column 4, lines 46-57) the use of RF over microwave thereby providing a teaching of obviousness why one skilled in the art would modify Sogawa et al to use RF energy as a substitute for microwave energy.

8. Applicant's arguments filed 07/25/05 have been fully considered but they are not persuasive. Applicant argues that Abele et al and not Sogawa et al is the primary reference and that Abele et al is the device being modified. The examiner's position is that this is incorrect and Sogawa et al is in fact the primary reference. Sogawa et al, as discussed above, teaches the claimed device except for specifically stating or teaching that the device is configured to be inserted into a natural body orifice, i.e. through an endoscope. Abele et al is used to provide a teaching that similar devices including elongate members having an antenna in a balloon member are well known to be inserted into the body using an endoscope, therefore the modification is to Sogawa et al.

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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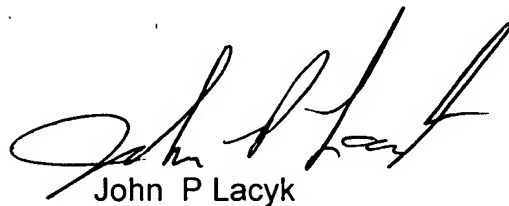
references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Abele et al provides a motivation to combine the references through teachings in the reference, as indicated in the rejection above, and by what the references themselves teach and knowledge of one skilled in the art. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is 571-272-4728. The examiner can normally be reached on Mon-Fri, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "John P. Lacyk", is positioned above the printed name and title.

John P Lacyk  
Primary Examiner  
Art Unit 3736

J.P. Lacyk